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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER
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05252004

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

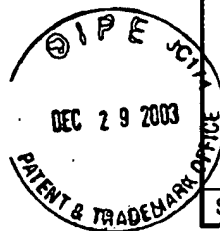
The prior art, submitted separately on 12/29/03, 03/24/04 and 04/08/04, have been considered. The prior art submitted is either not available because the present application predates the references, or predominantly the submissions are excerpts from various judicial proceedings which are not available for consideration as prior art. Nonetheless, the references have been reviewed and made of record.

Jeffrey R. Snay  
Primary Examiner  
Art Unit: 1743

Please type a plus sign (+) inside this box. → +

PTO/SB/08A (08-00)  
Approved for use through 10/31/2002. OMB 0651-0031  
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Substitute for form 1449A/PTO  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  <i>(Use as many sheets as necessary)</i>				<b>Complete if Known</b>	
Sheet	1	of	1	Application Number	08/968,208
				Filing Date	November 12, 1997
				First Named Inventor	Russell G. Higuchi
				Group Art Unit	1743
				Examiner Name	Jeffrey R. Snay
				Attorney Docket No.	4380 US

U.S. PATENT DOCUMENTS						
Examiner Initials*	Cite No. <sup>1</sup>	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines Where Relevant Passages or Relevant Figures Appear
		Number	Kind Code <sup>2</sup> (if known)			

FOREIGN PATENT DOCUMENTS								
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document			Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
		Office <sup>3</sup>	Number <sup>4</sup>	Kind Code <sup>5</sup> (if known)				

OTHER ART - NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
J.R.	51	Appeal Brief submitted by Bio-Rad to the Japanese Patent Office on October 30, 2003 seeking invalidation of counterpart Japanese Patent No. 3136129 (English translation only)	
J.R.	52	Full copy of "Report on Evolution Research," Department of Biochemical Kinetics, Max Planck Institut für Biophysikalische Chemie, allegedly published April 18-20, 1991, submitted as Exhibit 8 in item 51 above, portions of which were cited in this application as item 41 on the Form 1449A submitted to the Patent Office on or about Oct. 24, 2003	

Examiner Signature <span style="font-family: cursive; font-size: 1.2em;">J.R.</span>	Date Considered <span style="font-family: cursive; font-size: 1.2em;">5/25/04</span>
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Unique citation designation number. <sup>2</sup> See attached Kinds of U.S. Patent Documents. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

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**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(use as many sheets as necessary)

Applicati n Number 08/968,208

Filing Date 11/12/1997

First Named Inventor Russell G. Higuchi

Art Unit 1743

Examiner Name J. Snay

She t of Attorney Docket Number 4380US

**U.S. PATENT DOCUMENTS**

*Examiner Initials	Cite No.	DOCUMENT NUMBER Number - Kind Code (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
JS	51	US- 5,552,580	09/03/1996	Pfost et al.	
		US-			
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**FOREIGN PATENT DOCUMENTS**

*Examiner Initial	Cite No.	FOREIGN PATENT DOCUMENT		Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	TRANSLATION	
		Country Code:	Number - Kind Code (if known)				YES	NO
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**OTHER DOCUMENTS - NON-PATENT LITERATURE DOCUMENTS**

Examiner Initials	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published	TRANSLATION	
			YES	NO
JS	52	Decision by Japanese Patent Office dated December 25, 2003 in Invalidation Appeal No. 2002-35399 (English language translation only)	<input checked="" type="checkbox"/>	<input type="checkbox"/>
	53	Bio-Rad Brief dated October 30, 2003 filed with the Japanese Patent Office in Invalidation Appeal No. 2003-35449 (English language translation only)	<input checked="" type="checkbox"/>	<input type="checkbox"/>
	54	Exhibit Ko No. 8 from Cite No. 53 (Eigen et al., allegedly April 18-20, 1991, "Report on Evolution Research," Department of Biochemical Kinetics, Max Planck Institute Fur Biophysikalische Chemie, complete document)	<input checked="" type="checkbox"/>	<input type="checkbox"/>
	55	Bio-Rad Protest Brief dated November 19, 2003 filed with the Tokyo District Court in PE Corp. (NY) vs. Bio-Rad, Tokyo District Court No. H-15 (mo) 15045 (English language translation only)	<input checked="" type="checkbox"/>	<input type="checkbox"/>
	56	Applera Summary of Arguments dated January 7, 2004 filed with the Tokyo District Court in PE Corp. (NY) vs. Bio-Rad, Tokyo District Court No. H-15 (mo) 15045 (English language translation only)	<input checked="" type="checkbox"/>	<input type="checkbox"/>
	57	Applera First Statement dated January 14, 2004 filed with the Tokyo District Court in PE Corp. (NY) vs. Bio-Rad, Tokyo District Court No. H-15 (mo) 15045 (English language translation only)	<input checked="" type="checkbox"/>	<input type="checkbox"/>
	58	Bio-Rad Second Statement dated February 20, 2004 filed with the Tokyo District Court in PE Corp. (NY) vs. Bio-Rad, Tokyo District Court No. H-15 (mo) 15045 (English language translation only)	<input checked="" type="checkbox"/>	<input type="checkbox"/>
	59	Exhibit No. 21 from Cite No. 58 (Eigen et al., "Report on the International Workshop Selection—Natural and Unnatural—In Biotechnology")	<input checked="" type="checkbox"/>	<input type="checkbox"/>
	60	Applera Response to Oppositions and Intervention against EP 0 872 562 filed in the European Patent Office February 2, 2004	<input type="checkbox"/>	<input type="checkbox"/>
	61	Applera Complaint dated February 7, 2003 filed in Applera v. Bio-Rad, Dusseldorf Regional Court Case No. 4a O 44/03 (English language translation only)	<input checked="" type="checkbox"/>	<input type="checkbox"/>
JS	62	Bio-Rad Reply Brief dated November 17, 2003 filed in Applera v. Bio-Rad, Dusseldorf Regional Court Case No. 4a O 44/03 (English language translation only)	<input checked="" type="checkbox"/>	<input type="checkbox"/>

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Art Unit 1743

Examiner Name J. Snay

Sheet

of

Attorney Docket Number 4380US

63	Exhibit B11 from Cite No. 62 (Eigen et al., allegedly April 18-20, 1991, "Report on Evolution Research", pp. i, 1, 2, 53-56 and 65)	<input checked="" type="checkbox"/>	<input type="checkbox"/>
64	Exhibit B11a from Cite No. 62 (undated and unsworn statement by Prof. Manfred Eigen)	<input checked="" type="checkbox"/>	<input type="checkbox"/>
65	Applera Brief (adding another product) dated December 4, 2003 filed in Applera v. Bio-Rad, Dusseldorf Regional Court Case No. 4a O 44/03 (English language translation only)	<input checked="" type="checkbox"/>	<input type="checkbox"/>
66	Applera Reply Brief dated February 2, 2004 filed in Applera v. Bio-Rad, Dusseldorf Regional Court Case No. 4a O 44/03 (English language translation only)	<input checked="" type="checkbox"/>	<input type="checkbox"/>
67	Applera Extension of Claim (Patent in Suit III) dated June 20, 2003 filed in Applera v. MJ Research, Dusseldorf Regional Court Case No. 4a O 262/02 (English language translation only)	<input checked="" type="checkbox"/>	<input type="checkbox"/>
68	MJ Research Motion (Requesting Stay of Suit Pending Outcome of Opposition) dated December 8, 2003 filed in Applera v. MJ Research, Dusseldorf Regional Court Case No. 4a O 262/02 (English language translation only)	<input checked="" type="checkbox"/>	<input type="checkbox"/>
69	Applera Response dated February 16, 2004 filed in Applera v. MJ Research, Dusseldorf Regional Court Case No. 4a O 262/02 (English language translation only)	<input checked="" type="checkbox"/>	<input type="checkbox"/>
70	Applera Corporation's Claim Construction Brief for U.S. Patent No. 5,552,580 (with copy of Expert Report of Dr. Joseph Jaklevic)	<input type="checkbox"/>	<input type="checkbox"/>
71	Applera Corporation's Corrected Claim Construction Brief for U.S. Patent No. 5,552,580 (with copy of Notice of Filing of same)		
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75		<input type="checkbox"/>	<input type="checkbox"/>

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			YES	NO
<i>JS</i>	72	Bio-Rad Reply Brief dated March 22, 2004 filed in Applera v. Bio-Rad, Düsseldorf Regional Court Case No. 4a O 44/03 (English language translation only)	<input checked="" type="checkbox"/>	<input type="checkbox"/>
<i>JS</i>	73	Exhibit Collection B14 from Cite No. 72	<input checked="" type="checkbox"/>	<input type="checkbox"/>
<i>JS</i>	74	Applera Answer dated March 29, 2004 filed in Applera v. Bio-Rad, Düsseldorf Regional Court Case No. 4a O 44/03 (English language translation only)	<input checked="" type="checkbox"/>	<input type="checkbox"/>
<i>JS</i>	75	MJ Research Answer dated March 26, 2004 filed in Applera v. MJ Research, Düsseldorf Regional Court Case No. 4a O 235/03 (English language translation only)	<input checked="" type="checkbox"/>	<input type="checkbox"/>
	76		<input type="checkbox"/>	<input type="checkbox"/>
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	78		<input type="checkbox"/>	<input type="checkbox"/>
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	81		<input type="checkbox"/>	<input type="checkbox"/>
	82		<input type="checkbox"/>	<input type="checkbox"/>

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*J. Snay*

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5/25/04

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